

REMARKS

In the Final Office Action,¹ the Examiner rejected claims 2-5, 7, and 8 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,739,548² to Revital et al. (“Revital”) in view of U.S. Patent Application Publication No. 2002/0001386 of Akiyama (“Akiyama”) and in view of U.S. Patent No. 7,310,810 to Hamada et al. (“Hamada”).

By this Amendment, Applicants propose to amend claims 2, 7, and 8.

Claims 2-5, 7, and 8 are currently pending, with claims 2, 7, and 8 being independent. Claims 1, 6, and 9 were previously canceled without prejudice or disclaimer. Based on the foregoing amendments and the following remarks, Applicants respectfully request reconsideration and allowance of the pending claims.

I. The § 103(a) Rejection of Claims 2-5, 7, and 8

Applicants respectfully traverse the § 103(a) rejection of claims 2-5, 7 and 8 over Revital in view of Akiyama and in view of Hamada. A *prima facie* case of obviousness has not been established with respect to claims 2-5, 7, and 8.

Amended independent claim 2 recites, among other things, “the plurality of sublicenses including a first sublicense and a second sublicense, the first sublicense and the second sublicense being separate in a manner that the first sublicense includes a subcondition specific for the first content and the second sublicense includes a

1 The Final Office Action may contain statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Final Office Action.

2 Although the Final Office Action cites U.S. Patent No. 7,739,548, the Examiner informed Applicants’ representative via telephone on April 29, 2009, that the Examiner should have cited U.S. Patent No. 7,379,548. Applicants respectfully request appropriate corrections in any future correspondence.

subcondition specific for the second content, the first content being unrelated to the second content in a manner that the first content can be reproduced without the second content, the first sublicense and the second sublicense being added to the first content such that the sublicense acquisition means acquires the first sublicense and the second sublicense while the first content is being acquired.” Revital, Akiyama, and Hamada, taken alone or in combination, fail to teach or suggest at least these recited elements of amended independent claim 2.

The Examiner correctly observed that “Revital is . . . silent in explicitly disclosing the first content being unrelated to the second content in a manner that the first content can be reproduced without the second content, the first sublicense and the second sublicense being added to the first content such that the sublicense acquisition means acquires the first sublicense and the second [sub]license while the first content is being acquired.” Final Office Action at 5. Akiyama does not teach or suggest the above recited elements of amended independent claim 2, and the Final Office Action does not dispute otherwise as Akiyama is relied upon only for its alleged teachings of other elements recited in amended independent claim 2. See Id. The Examiner, however, attempted to cure the deficiencies of Revital by relying on Hamada. The Examiner asserted that “[p]rior art Hamada teaches an ECM can include the license information for multiple content and it sent in one ECM prior to the second content being delivered (col. 11, line 64-col. 12, line 11 and col. 16, line 54-col. 17, line 14 and lines 52-65).” Final Office Action at 5.

Even assuming, *arguendo*, that the Examiner’s assertion were true, which Applicants do not concede, Hamada fails to teach or suggest “the first sublicense and

the second sublicense being separate in a manner that the first sublicense includes a subcondition specific for the first content and the second sublicense includes a subcondition specific for the second content," as recited in amended independent claim 2. According to the Examiner, "the license information for multiple content" is included in one ECM of Hamada. Final Office Action at 5 (citing Hamada, col. 11, line 64 - col. 12, line 11; col. 16, line 54 - col. 17, line 14; col. 17, lines 52-65). Thus, based on the Examiner's assertion, Hamada fails to teach or suggest the above recited element of amended independent claim 2.

In addition, Hamada discloses extracting an ECM prior to determining whether any downloadable musical piece exists. Hamada, FIG. 13, S11 and S12; col. 17, lines 4-13. Thus, a TS packet including ECM of Hamada is received within the scrambler 32 before any of the three musical pieces is downloaded. See Hamada, col. 17, lines 4-13. Therefore, Hamada fails to teach or suggest that "the first sublicense and the second sublicense being added to the first content such that the sublicense acquisition means acquires the first sublicense and the second sublicense while the first content is being acquired," as recited in amended independent claim 2.

Simply put, one ECM containing information about three musical pieces and being received prior to downloading any of the three musical pieces, do not teach or suggest "the first sublicense and the second sublicense being separate in a manner that the first sublicense includes a subcondition specific for the first content and the second sublicense includes a subcondition specific for the second content, . . . the first sublicense and the second sublicense being added to the first content such that the

sublicense acquisition means acquires the first sublicense and the second sublicense while the first content is being acquired," as recited in amended independent claim 2.

In view of the above-noted deficiencies of the Revital, Akiyama, and Hamada references, the Final Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and claim 2. Also in view of those deficiencies, no combination of the applied references can possibly yield claim 2, nor could claim 2 have been predictable from the applied references. Further in view of those deficiencies, there would have been no motivation for one of ordinary skill in the art to modify the teachings of the references to achieve Applicants' claimed combinations. Thus, the Final Office Action has failed to clearly articulate a reason why claim 2 would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 2, and the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Amended independent claims 7 and 8, although of different scope, recite elements that are similar to the elements recited in amended independent claim 2. For reasons similar to the reasons set forth above with respect to amended independent claim 2, a *prima facie* case of obviousness has not been established with respect to amended independent claims 7 and 8, and therefore, the rejection of independent claims 7 and 8 under 35 U.S.C. § 103(a) should be withdrawn.

Dependent claims 3-5 depend from amended independent claim 2. Dependent claims 3-5 are thus allowable at least by virtue of their dependence from an allowable independent claim. Accordingly, Applicants respectfully request reconsideration and

withdrawal of the § 103(a) rejection claims 3-5 based on Revital, Akiyama, and Hamada.

II. Conclusion

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 2-5, 7, and 8 in condition for allowance.

Applicants submit that the proposed amendments of claims 2, 7, and 8 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge
any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: September 14, 2010

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